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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/706,065

11/12/2003

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EXAMINER

NICHOLSON III, LESLIE AUGUST

ART UNIT

PAPER NUMBER

3651

MAIL DATE

DELIVERY MODE

12/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--|---|--|
| Office Action Summary | Application No. 10/706,065 | Applicant(s) SITTINGER ET AL. | |
| | Examiner Leslie A. Nicholson III | Art Unit 3651 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/17/2006 has been entered.

Response to Arguments

2. Applicant's arguments with respect to the rejection(s) of claim(s) 1-54 under prior art references have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made. See below.

Applicant's arguments regarding the 35 USC 112 1st and 2nd paragraph rejections have been fully considered but they are not persuasive. Applicant has not admitted to having possession of the claimed invention at the time the application was filed (which is the requirement to 35 USC 112 1st paragraph, see ¶3). In fact, the Applicant has admitted that the limitation in question (see ¶4) was not the Applicant's invention at the time the application was filed. Applicant has referred to reference USP 6,327,599 having this limitation and is therefore not the Applicant's invention.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims recite that the printer prints customized content on at least a portion of at least one of the pages "without limitation as to position and orientation of the customized content over an entire surface of the at least one page". There is no support for this limitation in the specification as originally filed.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 53,54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are method claims which depend from apparatus claims.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1,2,8,9,13,23,24,30,31,35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dooley USP 6,257,566 in view of Warmus USP 6,327,599.

Dooley discloses a book production device that includes a gathering line (14); a demand printer (56); a feeding device (58); a packer box (16) with a transfer mechanism (see col. 4, line 3); and a controller (60). Dooley does not expressly disclose means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page.

Warmus teaches means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page (at least C7/L36-49, fig.6-8) for the purpose of permitting high speed printing to the production of differing books with customized and/or personalized information within a single production run (C4/L4-8).

At the time of invention it would have been obvious to one having ordinary skill in the art to employ means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page, as taught by Warmus, in the device of Dooley, for the

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purpose of permitting high speed printing to the production of differing books with customized and/or personalized information within a single production run.

9. Claims 1,2,12-16,20,22-24,35-38,43-45,49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graushar USP 5,100,116 in view of Warmus USP 6,327,599.

Graushar discloses a book production device that includes a gathering line (18); a plurality of demand printers (32, see col. 4, line 51); a feeding device (33); and a controller (31). Graushar does not expressly disclose means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page.

Warmus teaches means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page (at least C7/L36-49, fig.6-8) for the purpose of permitting high speed printing to the production of differing books with customized and/or personalized information within a single production run (C4/L4-8).

At the time of invention it would have been obvious to one having ordinary skill in the art to employ means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page, as taught by Warmus, in the device (or method) of Graushar, for the purpose of permitting high speed printing to the production of differing books with customized and/or personalized information within a single production run.

10. Claims 1,2,6,7,12-18,20,22-24,28,29,35-38,41,43-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weller USP 4,989,850 in view of Warmus USP 6,327,599.

Weller discloses a book production apparatus that includes a gathering line (90); a plurality of demand printers (75, see col. 5, lines 1-6); a feeding device (GR); a folding device (see col. 4, line 56); and a controller (see col. 3, line 56). Weller does not expressly disclose means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page.

Warmus teaches means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page (at least C7/L36-49, fig.6-8) for the purpose of permitting high speed printing to the production of differing books with customized and/or personalized information within a single production run (C4/L4-8).

At the time of invention it would have been obvious to one having ordinary skill in the art to employ means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page, as taught by Warmus, in the device (or method) of Weller, for the purpose of permitting high speed printing to the production of differing books with customized and/or personalized information within a single production run.

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11. Claims 3-5,25-27,39,40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graushar USP 5,100,116 in view of Warmus USP 6,327,599 further in view of Warmus USP 5,963,968.

Graushar discloses all the limitations of the claims, but it does not disclose utilizing a template file having fixed and variable information separated into data streams and provided to a collator/raster image processor together with a database and a press command file.

However, Warmus ('968) discloses a book production device that includes disclose utilizing a template file having fixed and variable information separated into data streams and provided to a collator/raster image processor together with a database and a press command file for the purpose of producing differing book versions in an efficient manner (see col. 3, lines 8-10).

It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Graushar by utilizing a template file having fixed and variable information separated into data streams and provided to a collator/raster image processor together with a database and a press command file, as disclosed by Warmus ('968), for the purpose of producing differing book versions in an efficient manner.

12. Claims 10,11,14,17,19,32,33,34 rejected under 35 U.S.C. 103(a) as being unpatentable over Dooley USP 6,257,566 in view of Warmus USP 6,327,599 further in view of Weller USP 4,989,850.

Dooley discloses all the limitations of the claims, but it does not disclose a folder and it does not disclose a plurality of demand printers.

However, Weller discloses a book production device that includes a folder for the purpose of processing signatures which have not been folded (see col. 3, lines 4-6) and Weller discloses utilizing a plurality of demand printers for the purpose of customizing more than one page.

It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Dooley by utilizing a folder and a plurality of demand printers, as disclosed by Weller, for the purpose of processing signatures which have not been folded and customizing more than one page.

13. Claims 14,21,36,42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dooley USP 6,257,566 in view of Warmus USP 6,327,599 further in view of Graushar USP 5,100,116.

Dooley discloses all the limitations of the claims, but it does not disclose a plurality of demand printers.

However, Graushar discloses a book production device that includes a plurality of demand printers for the purpose of customizing more than one page.

It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Dooley by utilizing a plurality of demand printers, as disclosed by Graushar, for the purpose of customizing more than one page.

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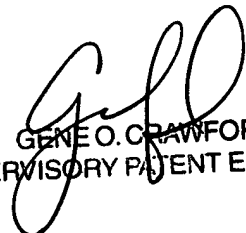
Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie A. Nicholson III whose telephone number is 571-272-5487. The examiner can normally be reached on M-F, 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on 571-272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

L.N.
10/30/2006


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